

12. (New) A method according to Claim 6, wherein the second predetermined temperature range is less than 120°C.

REMARKS

Formal notification of the allowability of all claims as now presented are earnestly solicited in light of the above amendments and remarks which follow.

Claims 6-12 are pending in the application. The new claims include the amended versions of Claims 8 and 9 submitted in an after-final amendment in the parent application (09/129,911). Amended Claims 8 and 9 were never examined in the parent case because the Advisory Action issued therein concluded that the amendments to those claims raised new issues necessitating new search or consideration. Claims 1-5 have been cancelled without prejudice or disclaimer.

In the parent application, Claims 6-12 were rejected under 35 U.S.C. §112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventors had possession of the claimed invention. Specifically, the Office Action alleged that the scope of the "varying the temperature..." recitation is unclear, suggesting that this limitation either means that one temperature range is selected and maintained or that the temperature is continuously changed between the two different ranges. The Office Action treated the recitation as meaning that a temperature range is selected and maintained for purposes of examination. Applicants respectfully traverse this rejection as applied to the pending application.

Applicants respectfully submit that the "varying the temperature" recitation is perfectly clear in light of the teachings of the specification. As taught on page 36 of Applicants' specification, the temperature is varied between the two ranges depending on whether market conditions are favorable for α -gypsum hemihydrate or gypsum dihydrate. There is no basis in the specification for asserting that this recitation must be construed as either meaning that the temperature is continuously changing or maintained in a single temperature range. The very plain language of the claim limitation requires that the temperature be varied between two

temperature ranges. Thus, the meaning attributed to this claim limitation in the Office Action is clearly improper and inconsistent with the literal language of the claim. Further, it is inaccurate and improper to state that the only other possible meaning for this claim limitation is that the temperature is continuously changed. There is no support for this construction of the limitation in the specification. In contrast, as noted above, the specification very clearly indicates that the temperature is varied between the two ranges depending on market conditions for the two possible products. Given this clear teaching, the claim recitation objected to in the Office Action is adequately described and fully enabled by Applicants' specification. Further, Applicants respectfully request that this limitation be given a meaning consistent with the clear teachings of the specification.

Claims 6-12 were also rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard to as the invention. Specifically, the Office Action alleged that it is unclear where it is disclosed in the specification that the temperature is varied between two temperature ranges. As Applicants have stated above, this aspect of the invention is clearly described on page 36 of Applicants' specification. Further support may be found on pages 13 and 21-22, as well as throughout the remainder of the specification. Additionally, the Office Action stated that "sulfurous acid" in Claims 8 and 9 has no antecedent basis. As now presented, Claims 8-9 provide clear antecedent basis for sulfurous acid.

Claims 6 and 10-11 were also rejected under 35 U.S.C. §102(b) as being anticipated by either JP 1-254226 or JP 63-123801. Further, Claims 7-9 and 12-14 were rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of the above two Japanese references. Applicants respectfully traverse these rejections as applied to the present claims.

As discussed above, the Office Action in the parent application relied upon an erroneous construction of the "varying the temperature" recitation in Claim 6. The meaning attributed to this recitation by the Office is contrary to the plain meaning of the recitation and essentially reads the recitation out of the claim, enabling the Office Action to reject the claims over art that clearly fails to teach or suggest this limitation. The reasonable interpretation of this claim limitation outlined above renders the pending claims patentable over the cited references. The Office

Action did not allege that the cited references, either singly or in combination, teach a step of varying the temperature of a calcium-containing liquid slurry stream between two predetermined temperature ranges. In fact, the Office Action appears to admit that this teaching is absent from the cited references. Thus, if this claim limitation is given a reasonable interpretation consistent with the specification, the claimed subject matter set forth in Claims 6-12 is patentable over the cited references.

As Applicants have stated, a reasonable interpretation of this limitation is that the temperature is varied between the first temperature range and the second temperature range in order to selectively precipitate one of two gypsum compounds in response to changes in the market conditions for the two compounds. As taught on page 36, when there is sufficient demand for α -gypsum hemihydrate in the market, the temperature is varied to the temperature range that selectively precipitates that compound. However, when the market for α -gypsum hemihydrate is unfavorable, the temperature range may be varied in order to selectively precipitate gypsum dihydrate, which is easier to store and convey. As a result, Applicants respectfully request that the rejections made in the parent application are not sustainable.

It is respectfully submitted that Applicants have made a significant and important contribution to the art, which is neither disclosed nor suggested in the art. It is believed that all pending claims are now in condition for immediate allowance. It is requested that the Examiner telephone the undersigned should the Examiner have any comments or suggestions in order to expedite examination of this case.

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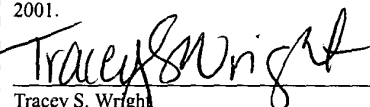
It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,



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| <p>"Express Mail" Mailing Label Number Date of Deposit: April 25, 2001</p> <p>I hereby certify that this paper or fee is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to Box Patent Application, Commissioner for Patents, Washington, DC 20231.</p> <p>_____</p> | <p>CERTIFICATE OF MAILING</p> <p>I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Box Non-Fee Amendment, Commissioner for Patents, Washington, DC 20231, on April 26, 2001.</p> <p> Tracey S. Wright</p> |
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